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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/766,298

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Keirou Shinkawa

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09/08/2004

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EXAMINER

RAMAN, USHA

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,298

Applicant(s)

SHINKAWA ET AL.

Examiner

Usha Raman

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED OFFICE ACTION**

### ***Specification***

1. The disclosure is objected to because the specification contains numerous grammatical errors and unclear phrasing apparently resulting from the Japanese translation. Applicant is requested to review and revise the specification accordingly. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 2, it is not clearly stated whether the transmitting means refers back to the transmitting means of the search apparatus or the transmitting means of the transmitting apparatus.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-16, and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US Pre Grant Pub. 2003/0020744).

In regards to claim 1, 7, and 11, Ellis discloses a head end server that is capable of receiving requests from user and servicing the request by "searching" local and other remote program source databases and transmitting the requested information to the user. The system comprises one or more data source facilities providing "unique information" (i.e. program listing, video data and advertisements) to a local head end. The one or more data source facilities transmit data their unique information through a channel for exclusive use therefor, over a communication link such as a satellite uplink. Note paragraph 6 in page 1. Ellis further illustrates an example of the plural number of transmitters (main facility, 12, and local information service, 15) supplying their unique information to the head end (television distribution facility, 17) in figure 1. The system comprises a receiving apparatus (user equipment, 22), having a receiving means for receiving the "unique information" through a channel other than the predetermined channel (i.e. data that is transmitted from a data source facility to the satellite is transmitted at a different channel than the data transmitted from the satellite to the television distribution facility). The receiving apparatus comprises a search request means for requesting a search or retrieval of the unique information (EPG data, pay per view programs, video on demand, and other programming services), The system also comprises a "search" apparatus with receiving means that receives program guide data, and other programming data from data sources at main facility (the plurality of

transmitting apparatuses), storage means (56) for storing the unique information received from the transmitting apparatuses, a search processing means for processing the request for a service relating to the unique information from the receiving apparatus, and a transmitting means for transmitting the requested query or search information on the unique information to the receiving apparatus. A search request comprises a query submitted from the receiving apparatus to the search apparatus, such as requests for a receiving program (VOD, pay per view request), scheduling recording or reminders, as well as program listing information (and request for formatting them by categories, etc.).

In regards to claim 2, and 8, Ellis discloses that the receiving apparatus displays a search screen (via the program guide client user interface) information at the receiver apparatus so that search requests can be made by operating the search screen. See figures 9a and 9c.

In regards to claim 3, 9 and 16, Ellis discloses that viewing histories are used for tracking programs user watched, including pay per view (i.e. programming information that user received). The receiving apparatus can transmit the viewing history to the program server periodically or in response to requests from the program server. Such a transmission scheme inherently requires the receiving apparatus to store the viewing history in a "safekeeping" means until its ready to be transmitted to the program guide server. Note paragraph 125 in page 13.

In regards to claim 4, 10 and 12, among the data transmitted by the data sources to the television distribution facility are program guide data, therefore the unique information includes guide information on programs and information about contents of the programs. Note paragraph 6 in page 1.

In regards to claim 5, 13 and 18, Ellis discloses that the television distribution facility provides pay per view programs (as well as other merchandise) that can be ordered by a viewer. Therefore the search system inherently has a charge determination means for determining the charge information to be paid depending upon the content which is searched by the search means in order to facilitate a purchase of a pay per view program and merchandises. Note paragraph 39 in page 3 and paragraph 66 in page 6.

In regards to claim 6, 14 and 19, the program guide server may construct relational database expressions from viewing histories (i.e. form a viewer trend based on viewing history) that are used to generate personalized viewing recommendations. Note paragraph 111 in page 11.

In regards to claim 15, Ellis discloses that multiple users can be associated with a single television equipment and in such an event, there are multiple user profiles catering to each of the plurality of users, and a session for a particular user is identified by selecting their respective profile. Note paragraph 87 in page 8. By switching to a particular user profile, the system comprises the method of accepting the step for starting a service to a specific user upon receipt of information (user profile) relating to the specific user. In regards to the steps

of searching information and transmitting content, please see claims 1, 7 and 11 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US Pre Grant Pub. 2003/0020744).

In regards to claim 17, Ellis does not disclose that the profile information relating to the user includes the recited limitation. Official notice is taken that it is well known to include data such as a user's name or an age in a user's profile. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the user's age in the profile as a demographic data in order provide better program recommendations catered to users the of that age.

***Conclusion***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax

phone number for the organization where this application or proceeding is assigned is 703-308-5359.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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09-03-04



VIVEK SRIVASTAVA  
PRIMARY EXAMINER